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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,904	04/30/2001	Noel Morel	34232-PCT-USA-A-070337.02	3706

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NEW YORK, NY 10112

EXAMINER

KNABLE, GEOFFREY L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 06/17/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/845,904

Applicant(s)

MOREL, NOEL

Examiner

Geoffrey L. Knable

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,6,7 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 and 11 is/are allowed.
- 6) ☒ Claim(s) 1,2,6,7,12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3-28-03 has been entered.

2. Claims 12-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

New claims 12-13 define a tire component made of two vulcanized rubber mixtures. The original disclosure however does not explicitly describe that the invention contemplates a "tire component" of vulcanized rubber but rather describes either a tire or an article. This new reference to a claim directed to a "tire component made of vulcanized rubber" is thus considered to contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to be new matter.

Claim 13 additionally indicates that the tire component is a tread band. Although the original disclosure does describe a tire in which the joint between the tread and sidewall is configured with an oscillatory trace, there is no original description of a tire

component in the form of a vulcanized tread band that itself includes a lap joint therein.

Claim 13 thus likewise contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to add new matter on this grounds as well.

3. Claims 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 13, it is not entirely clear what the scope of a "tire component made of vulcanized rubber" is intended to be. In particular, and as noted in the previous paragraph, the original disclosure never uses this terminology and never describes the invention in the context of a stand alone tire component, it therefore being difficult to determine the intended scope of these new claims, at least when read in the context of what was originally described (i.e. a tire or article, but not a "tire component").

4. Claims 1, 2 and 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brayer (US 5,538,059) as applied in the last office action.

5. Claims 1, 2, 6, 7 and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Cuthbertson et al. (US 2,789,616) or JP 53-146779 to Mitsubishi or JP 62-6801 to Bridgestone.

These reference are applied as in the last office action. As to new claims 12-13, it is not considered at present that the reference to a *tire component* clearly or

unambiguously defines over a *tire* configured so as to meet the claimed requirements, particularly when this terminology is read in light of the original disclosure.

6. Claims 10 and 11 are allowed for the reasons set forth in the last office action with respect to claims 8-9.

7. Applicant's arguments filed 3-28-03 have been fully considered but they are not persuasive as regards any remaining rejections.

The rejection over Doherty has however been withdrawn in light of the amendment to claim 1 expressly reciting a tire.

As to the rejection based upon Brayer, applicant urges that this reference has a plurality of independent rubber sections 18A rather than a layer. This argument has been considered but is unpersuasive as the sections 18A in fig. 2 were *not* referenced or relied upon in the rejection. Rather, as clearly set forth in the previous statement of rejection, it is the sections 18 in fig. 1 that are being referenced. Again, reference is made to the statement of rejection in the last office action.

As to Cuthbertson et al. it is argued that this reference teaches removal of the irregular line, it being argued that the reference "failed to recognize that the sidewall prior to removal of the oscillatory line was a new invention, and that therefore Cuthbertson et al. does not anticipated the present invention", reference being made also to *Heard v Burton*, 333, F.2d 239, 241-243 (CCPA 1964). This argument has been carefully considered but at present does not convincingly show why the intermediately produced molded article of the reference, that seems to meet each of the claimed features, does not anticipate the claims. The cited case is noted - however this case

does not appear to be on point as it is apparently dealing with issues of conception and reduction to practice in the area of interferences and applicant has not convincingly shown or argued why this supports a position that recognition that a disclosure is a new invention is a prerequisite to sustaining an anticipation rejection.

As to JP '779 to Mitsubishi, it is argued that this reference suggests that the tread concave parts are cut with regular tools and therefore like Cuthbertson discloses a regular not oscillatory line. This argument has been considered but is unpersuasive as how the reference forms the desired final configuration would not seem particularly relevant in this instance where the claims are drawn to a tire. Again, it would seem that JP '779 discloses a tire including different color rubbers 1 and 2 that are apparently lap jointed and have an edge that ends in an oscillatory trace line in the plane of the joint – note again esp. the joint between the layers 1 and 2 in fig. 2 and the periodic color changes at the joint. The darker or cross-hatched areas of the tread are clearly in a periodic form due to the periodic cutouts.

As to JP '801 to Bridgestone, it is argued that the incisions 9 are not in the plane of the joint and “are made during molding and are not present on the tread at the time of manufacture.” As to the incisions being in the plane of the joint, it is considered that the oscillation of the tread edge due to the incisions is in the plane of the tread and therefore in the plane of the joint with adjacent components. The second argument is not understood. The incisions are of course made during molding. What in the present claims (or even present disclosure) indicates that the trace line is present or required before molding? Note again that the present claims are directed to a tire with


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vulcanized mixes - i.e. a final molded tire is considered to be entirely consistent with this.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 703-308-2062. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Geoffrey L. Knable  
Primary Examiner  
Art Unit 1733

G. Knable  
June 14, 2003